



Paper No. 10

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Technology Center 2100

In re Application of: Guang-Ho Cha et al.)
Application No. 09/512,949)
Filed: February 25, 2000) **DECISION ON PETITION UNDER 37**
For: INDEXING SYSTEM AND METHOD) **C.F.R. § 1.181(a) TO INVOKE**
FOR NEAREST NEIGHBOR) **SUPERVISORY AUTHORITY**
SEARCHES IN HIGH)
DIMENSIONAL DATA SPACES)

This is a decision on a petition, filed 2 August 2002, under 37 C.F.R. § 1.181(a) to invoke supervisory Authority. The petition requested that the objections (1) to the specification (2) to the drawings and (3) to the declaration (as set forth in the Office action mailed 14 June 2002) be withdrawn.

The petition is **GRANTED-IN PART**.

RECENT PROSECUTION BACKGROUND

- April 10, 2002 - First non-final office action mailed. Examiner objected to drawings for failing to place textual label for each numbered element in figures 1-7. Examiner objected to disclosure for failing to capitalize trademarks recited therein and for the recitation of a paragraph proscribing the claims from being construed under 35 U.S.C. 112, 6th paragraph.
- April 19, 2002 - Petitioner filed a response with substitute drawings and asserted that the inclusion of the paragraph proscribing the claims from being construed under 112 6th was not impermissible by patent laws. Further, petitioner authorized the Examiner to correct improper trademark deficiencies in the specification.

June 6, 2002 - Second non-final office action mailed. Examiner objects to the declaration for non-initialed alterations contained therein. Further, Examiner reiterates objection to drawings for failing to place textual label for each numbered element in figures 3-7. Additionally, Examiner reiterates objection to disclosure for the recitation of a paragraph proscribing the claims from being construed under 35 U.S.C. 112, 6th paragraph.

August 2, 2002 - Petition filed.

RELIEF REQUESTED

The Petition requests the following relief:

- A. Withdrawal of the objection to the Declaration.
- B. Withdrawal of the objection to the Drawings.
- C. Withdrawal of the objection to the Specification.

BASIS OF OPINION

37 C.F.R. §1.63(c)(1) states in relevant part:

...

Unless such information is supplied on an application data sheet in accordance with § 1.76, the oath or declaration must also identify:

- (1) The mailing address, and the residence if an inventor lives at a location which is different from where the inventor customarily receives mail, of each inventor.

37 C.F.R. §1.52(c) states in relevant part:

...

(c) (1) Any interlineation, erasure, cancellation or other alteration of the application papers filed ***must be made before the signing*** of any accompanying oath or declaration pursuant to § 1.63 referring to those application papers ***and should be dated and initialed or signed*** by the applicant on the same sheet of paper. Application papers containing alterations made after the signing of an oath or declaration referring to those application papers must be supported by a supplemental oath or declaration under § 1.67. In either situation, a substitute specification (§ 1.125) is required if the application papers do not comply with paragraphs (a) and (b) of this section.

37 C.F.R. 1.84 Standards for Drawings

...

- (o) Legends . Suitable descriptive legends may be used subject to approval by the Office, or ***may be required by the examiner where necessary for understanding*** of the drawing. They should contain as few words as possible

OPINION

A. Objection to the Declaration under 37 C.F.R. § 1.52(c)

Petitioner maintains that objecting to the declaration simply because the inventor wrote in additional address information without initialing it is exalting form over substance. Petitioner further maintains that there is no regulatory basis for requiring such initialing since there is no requirement in the MPEP that when an inventor corrects his address as listed in the declaration by adding words to the title of his institution and writing the name of his country, he also initial it.

As a preliminary matter, Petitioner is reminded that, pursuant to 37 C.F.R. §1.63(c), the mailing address is a necessary and an integral part of the declaration. It must therefore conform to the requirements of 37 C.F.R. §1.52(c), according to which any alteration made to any part of the declaration before signing must be dated, initialed or signed. If such alteration was made after the signing of the declaration, initialing and dating said alteration would not be effective, and a supplemental oath or declaration would be required under 37 C.F.R. §1.67.

In the present case, since Petitioner did alter the declaration without actually initialing and dating such alteration before signing the declaration, a new declaration is required in accordance with 1.52(c).

The Examiner's objection to the declaration is therefore proper, and it is hereby **SUSTAINED**.

B. Objection to the Drawings under 37 C.F.R. §§ 1.84 (n)-(o)

Petitioner maintains that 37 C.F.R. §§1.84(n) and (o), under which the drawings are objected to, are cast in permissive language, and do not require that textual labels be placed next to each numbered drawings element.

37 C.F.R. §1.84 (n) requires that symbols in the drawings be adequately described in the specification. 37 C.F.R. §1.84(o) indicates that legends may be used in the drawings, and they must contain as few words as possible. Section 1.84 (o) allows the Examiner to require legends "where necessary for understanding of the drawing." We agree with Petitioner that sections (n) and (o) of 37 C.F.R. §1.84 do not provide any support for the Examiner's objection requesting Petitioner to place textual labels next to the numbered drawings elements *where they are not necessary for the understanding of the drawing*. Consequently, there is no need for labels on standard mathematical coordinate systems.

Accordingly, the objection to the drawings is overruled, and it is hereby **WITHDRAWN**.

C. Objection to the Specification under 37 C.F.R. § 1.71

Petitioner maintains that there is no provision in 37 C.F.R. §1.71 for law interpretations for the paragraph on pages 12-13 of the specification proscribing the claims from being construed under 35 U.S.C. 112, 6th paragraph.

A review of the 37 C.F.R. §1.71 reveals that such request to delete from the specification the paragraph proscribing the interpretation of the claims under 35 U.S.C. 112, 6th is not supported by the cited section of the MPEP.

Petitioner is free to make statements regarding patent laws. Petitioner's statements, however, will have no bearing on the Examiner's obligation to apply the laws as required in the patent examining guidelines and the controlling case law. Examiner's objection to the specification is overruled, and it is hereby **WITHDRAWN**.

Accordingly, the Petition is **GRANTED-IN PART**.

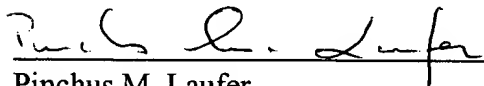
CONCLUSION

The Examiner is directed to withdraw the aforementioned objections to the drawings and the specification, and is specifically directed to mention such withdrawal in the next Office communication.

The application is being forwarded to the Examiner to issue an appropriate action in compliance with the guidelines set out above.

Any request for reconsideration must be filed within two months of the mailing date of this decision.

Inquiries with respect to this decision may be directed to Pinchus M. Laufer at (703) 306-4160.



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